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13
14 UNITED STATES DISTRICT COURT
15 SOUTHERN DISTRICT OF CALIFORNIA
16

17 GEN-PROBE INCORPORATED,
18 Plaintiff,
19 v.
20 VYSIS, INC.,
21 Defendant.

No. 99CV2668 H (AJB)

**DECLARATION OF R. WILLIAM BOWEN IN
SUPPORT OF OPPOSITION TO MOTION FOR
ENTRY OF FINAL JUDGMENT UNDER
RULE 54(B)**

Date: July 30, 2001
Time: 10:30 a.m.
Dept.: Courtroom 1

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I, R. William Bowen, declare as follows:

1. I am a member of the State Bar of California and admitted to practice before this Court. I am one of the counsel of record in this action for plaintiff Gen-Probe Incorporated.

2. On June 22, 1999, Gen-Probe entered into a preliminary agreement with defendant Vysis, Inc. for a royalty-bearing license of United States patent number 5,750,338 ("the '338 patent"). On August 11, 1999, Gen-Probe entered into a final agreement with defendant Vysis, Inc. for a royalty-bearing license of the '338 patent.

3. On December 21, 1999, Gen-Probe notified Vysis in writing that Gen-Probe believed the '338 patent was invalid and, further, did not cover any of Gen-Probe's products. At the same time, Gen-Probe notified Vysis in writing that it was filing this action to seek a judicial determination of the rights and obligations of the parties.

4. In February 18, 2000, Gen-Probe notified Vysis in writing that it intended to pay royalties under the license of the '338 patent pending final resolution of the causes of action asserted in this action, subject to a reservation of rights. A true and correct copy of this notice is attached as Exhibit 3 to the accompanying notice of lodgment. Gen-Probe made four quarterly royalty payments for calendar year 2000 and made the royalty payment due for the first quarter of 2001. Each of these payments was made subject to a reservation of rights. A true and correct copy of one of the letters transmitting a quarterly royalty report is attached as Exhibit 4 to the accompanying notice of lodgment.


5. The payment under the Collins patent license for the second quarter of 2001 will be due by August 30, 2001. As of the date of this declaration, Gen-Probe intends to continue making royalty payments, under a reservation of rights, pending the final resolution of all issues raised in this action.

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6. On July 2, 2001, Gen-Probe inquired of Vysis's counsel whether Vysis would agree to suspend the accrual of royalty obligations, without penalty, during the pendency of any stay occasioned by its motion for 54(b) certification. Vysis's counsel stated that Vysis would not agree to the suspension of royalty payments pending interlocutory appellate review.

I hereby declare under penalty of perjury that all statements made herein of my own knowledge are true and correct.

Executed at San Diego, California on July 9, 2001.


R. William Bowen

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